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EXAMINER

NEURAUTER, GEORGE C

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,138	MALIK, DALE W.	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,15 and 21-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,15 and 21-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-3, 6-8, 15, and 21-42 are currently presented and have been examined.

It is noted that a new Examiner has been assigned to this case. Any future correspondence regarding the instant application should be directed to the Examiner listed below.

Response to Arguments

Applicant's arguments filed 30 March 2006 have been fully considered but they are not persuasive.

The Applicant argues that the cited prior art does not teach or suggest determining whether a message has been previously compressed and then compacting the message if the message has not been previously compressed. The Examiner does not agree and concurs with the findings of the previous Examiner. As shown by the previous Examiner, data that was not previously compressed is compressed. Therefore, data that is determined to be not previously compressed is selected to be compressed and is no longer considered to be not previously compressed within the teachings of the cited prior art.

The Applicant also argues that the combined teachings of Arnold and Lafe do not teach or suggest performing an off-hours routine for checking an electronic message against a predetermined criterion. The Examiner is not persuaded by these

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arguments. The claims do not specifically specify what an "off-hours routine" is or when such a routine occurs including any triggers, thresholds, or ranges associated with the "off-hours routine". In view of the broadest reasonable interpretation of the claim, this limitation would be performed at any hour and/or on the occurrence of any event. As shown by the previous Examiner, the checking occurs when the message is received. Therefore, the cited prior art does disclose this limitation.

Therefore, the cited prior art does disclose the currently presented claims as amended and the claims are not in condition for allowance. The amendments made to the claims are subject to the same citations within the references and those cited above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

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establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848) in view of Lafe et al.

(U.S. Patent Number 6,449,658), hereinafter referred to as Lafe.

Regarding claim 1, Arnold disclosed a method for automatically managing a electronic mail server application on a host computer (Figure 1 signs 104 & 108, Figure 4, column 1 lines 39-57, column 4 lines 6-23), comprising the steps of: checking an electronic mail message against a predetermined criteria (Figure 4, column 1 lines 39-57, column 4 lines 6-23); determining whether the message has been previously compressed; and compacting the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed (Abstract, Figures 2&4, column 1 lines 39-57, column 3 lines 45-62, column 4 lines 6-23).

Arnold taught the invention substantially as claimed. However, Arnold did not expressly teach compacting a non-attachment portion of the electronic mail message.

Arnold suggested exploration of art and/or provided a reason to modify the managing electronic mail method with additional feature such as compacting the content of the electronic message (column 1 lines 26-37, column 1 line 63-column 2 line 13).

Lafe disclosed a method for managing electronic messages wherein the attachment and non-attachment portion of the electronic message is compacted (Abstract, Figures 5, 6A1, 7A-7B, column 5 lines 28-42, lines 53-54, column 6 lines 39-67, column 7 lines 11-13, column 8 lines 23-32).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Arnold with the teachings of Lafe to include the message content compaction feature in order to efficiently move information across a network (Lafe, Abstract) since seamless transport engine to move data quickly through the Internet is essential (column 1 lines 37-42).

Regarding claim 2, Arnold disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application [message

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switch] (Figures 1-2, column 1 lines 39-57, column 2 lines 27-37, column 3 lines 45-50).

Regarding claim 3, Arnold disclosed a method wherein the step of checking is performed periodically when the electronic mail message is received on the host computer (column 1 lines 39-57, column 2 lines 42-50, column 4 lines 9-19).

Regarding claim 6, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 12-19).

Regarding claim 7, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size [configurable factors] (column 1 lines 45-57, column 4 lines 12-17, lines 64-67).

Regarding claim 8, Arnold disclosed a method wherein the predetermined criteria comprise an attachment type [configurable factors] (column 5 lines 16-18, column 4 lines 12-17).

Regarding claim 15, Arnold disclosed a method further comprising the step of compressing the attachment (column 1 lines 38-41).

Regarding claim 21, Arnold and Lafe combined disclose a method for managing a user's electronic mailbox on a computer, comprising the steps of: performing an off-hours routine for checking an electronic mail message against a predetermined

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criteria (Arnold, Figure 4, column 1 lines 39-57, column 4 lines 6-23); and compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns (Arnold, Abstract, Figures 2&4, column 1 lines 39-57, column 3 lines 45-62, column 4 lines 6-23; Lafe, Abstract, Figures 5, 6A1, 7A-7B, column 5 lines 28-42, lines 53-54, column 6 lines 39-67, column 7 lines 11-13, column 8 lines 23-32).

Regarding claim 22, Lafe disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox (column lines 39-59, column 6 lines 60-67).

Regarding claim 23, Arnold disclosed a method wherein the step of checking is performed upon request by the user (column 2 line 56-column 3 line 2, column 4 lines 58-67).

Regarding claim 26, Arnold disclosed a method wherein the predetermined criteria comprises a total message size (column 4 lines 6-23).

Regarding claim 27, Arnold disclosed a method wherein the predetermined criteria comprises an attachment size (column 4 lines 6-24).

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Regarding claim 28, Arnold disclosed a method wherein the predetermined criteria comprises an attachment type (column 4 lines 6-24).

Regarding claim 30, Arnold disclosed a method wherein the location of the screening of the message is on a server (Figure 1, column 3 lines 45-56, column 4 lines 6-24).

Regarding claim 31, Lafe disclosed a method wherein the location of the screening of the message is on a client (column 6 lines 60-67).

Regarding claim 32, Arnold disclosed a method wherein the location of the screening of the message is configured by a user (column 2 line 56-column 3 line 2, column 4 lines 58-67).

Regarding claim 33, Arnold disclosed a method wherein the screening is performed periodically on the computer (column 6 lines 13-33).

Regarding claim 34, Lafe disclosed a method wherein the electronic mail message is compressed into a compressed file using various compression algorithms [zipped file]. Note: Zip compression algorithms are well known in the art at the time of the invention was made (column 5 lines 28-43). Refer to PTO-892 for prior art of record.

Regarding claims 35-42, the computer readable medium with logic embedded therein for executing on a computer for managing

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a user's electronic mailbox corresponds directly to the method of claims 21-23, 26-8, and 30-34, and thus these claims are rejected using the same rationale.

Since all the limitations of the claimed invention were disclosed by the combination of Arnold and Lafe, claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected.

Claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda et al. (U.S. Patent No. 6,275,850), hereinafter referred to as Beyda, in view of Hanson et al. (U.S. Patent Number 6,549,957), hereinafter referred to as Hanson.

Regarding claim 1, Beyda disclosed a method for automatically managing an electronic mail server application on a host computer, said method comprising the steps of checking an electronic mail message against a predetermined criteria (Figure 3, column 2 lines 42-63).

Beyda taught the invention substantially as claimed. However, Beyda did not expressly teach determining whether the message has been previously compressed and compacting the compacting a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed.

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Beyda suggested exploration of art and/or provided a reason to modify the method with the compacting the electronic message to minimize downloading time (Figure 3, column 1 lines 49-55).

Hanson disclosed a method for managing electronic messages wherein the non-attachment portions of the electronic mail message are compacted if predetermined criteria is satisfied and if the message has not been previously compressed (Figures 4A-4B, 6, 7A-7B, 8, column 5 lines 31-51, column 10 lines 54-column 11 lines 17).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Beyda with the teachings of Hanson to include the non-attachment compaction feature in order to reduce the size of the message (Hanson, column 5 lines 32-41, column 10 line 55-column 11 line 3) since accessing email messages may lead to an unproductive waiting period (Beyda, column 1 lines 47-49).

Regarding claim 2, Beyda disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23).

Regarding claim 3, Beyda disclosed a method wherein the step of checking is performed periodically when the electronic

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mail message is received on the host computer (Beyda, Figure 3, column 2 lines 42-50, column 4 lines 9-23).

Regarding claim 6, Beyda disclosed a method wherein the predetermined criteria comprise a total message size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

Regarding claim 7, Beyda disclosed a method wherein the predetermined criteria comprise an attachment size (Figure 3 sign 58, column 2 lines 51-63, column 4 lines 36-61).

Regarding claim 8, Beyda disclosed a method wherein the predetermined criteria comprise an attachment type (Figure 3, sign 62, column 2 lines 51-63, column 3 lines 41-3).

Regarding claim 15, Hanson disclosed a method further comprising the step of compressing the attachment (column 11 lines 4-17).

Regarding claim 21, Beyda and Hanson combined disclose a method for managing a user's electronic mailbox on a computer, comprising the steps of: performing an off-hours routine for checking an electronic mail message against a predetermined criteria (Beyda, Figure 3, column 2 lines 42-63); and compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message

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and encoding those patterns (Hanson, Figures 4A-4B, 6, 7A-7B, 8, column 5 lines 31-51, column 10 lines 54-column 11 lines 17).

Regarding claim 22, Beyda disclosed a method wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox (Beyda, Figure 3, column 5 line 59-column 6 line 5).

Regarding claim 23, Beyda disclosed a method wherein the step of checking is performed upon request by the user (column 4 lines 45-61, column 6 lines 35-49).

Regarding claim 26, Hanson disclosed a method wherein the predetermined criteria comprises a total message size (column 10 line 54-column 11 line 17).

Regarding claim 27, Beyda disclosed a method wherein the predetermined criteria comprises an attachment size (Abstract, Figure 3, column 3 lines 4-13).

Regarding claim 28, Beyda disclosed a method wherein the predetermined criteria comprises an attachment type (Abstract, Figure 3, column 3 lines 4-13).

Regarding claim 30, Beyda disclosed a method wherein the location of the screening of the message is on a server (Figure 3, column 5 line 59-column 6 line 5).

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Regarding claim 31, Hanson disclosed a method wherein the location of the screening of the message is on a client (column 10 line 54-column 11 line 17).

Regarding claim 32, Beyda disclosed a method wherein the location of the screening of the message is configured by a user (column 6 lines 35-49, column 7 lines 23-29, lines 40-45).

Regarding claim 33, Beyda and Hanson disclosed a method wherein the screening is performed periodically on the computer (Beyda, Figure 3, column 3 lines 31-35; Hanson, column 5 lines 31-51, column 10 line 54-column 11 line 3).

Regarding claim 34, Hanson disclosed a method wherein the electronic mail message is compressed into a zipped file (Hanson, Figures 4A-4B).

Regarding claims 35-42, the computer readable medium with logic embedded therein for executing on a computer for managing a user's electronic mailbox corresponds directly to the method of claims 21-23, 26-8, and 30-34, and thus these claims are rejected using the same rationale.

Since all the limitations of the claimed invention were disclosed by the combination of Beyda and Hanson, claims 1-3, 6-8, 15, 21-23, 26-28, and 30-42 are rejected.

Conclusion

It is noted that the column, line, and/or page number citations used in the prior art references as applied by the Examiner to the claimed invention are for the convenience of the Applicant to represent the relevant teachings of the prior art. The prior art references may contain further teachings and/or suggestions that may further distinguish the citations applied to the claims, therefore, the Applicant should consider the entirety of these prior art references during the process of responding to this Office Action. It is further noted that any alternative and nonpreferred embodiments as taught and/or suggested within the prior art references also constitute prior art and the prior art references may be relied upon for all the teachings would have reasonably suggested to one of ordinary skill in the art. See MPEP 2123.

The prior art listed in the PTO-892 form included with this Office Action disclose methods, systems, and apparatus similar to those claimed and recited in the specification. The Examiner has cited these references to evidence the level and/or knowledge of one of ordinary skill in the art at the time the invention was made, to provide support for universal facts and the technical reasoning for the rejections made in this Office Action including the Examiner's broadest reasonable

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interpretation of the claims as required by MPEP 2111 and to evidence the plain meaning of any terms not defined in the specification that are interpreted by the Examiner in accordance with MPEP 2111.01. The Applicant should consider these cited references when preparing a response to this Office Action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

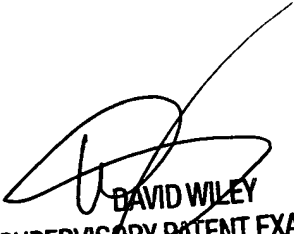
Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/gcn/


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